

REMARKS

Claims 1-26 are pending in the application, of which claims 23, 24 and 26 are withdrawn from consideration, and of which the Examiner rejects claims 1-22 and 25. Reconsideration of the pending claims is requested. The amendments are adequately supported in the originally-filed specification, drawings and claims. No new matter is added in this Reply.

35 USC § 112

The Examiner rejects claims 6 and 17-21 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant hereby requests leave to amend claim 6 to replace language directed to “said object surface” with language directed to “one of said objects” as previously set forth in the first element of claim 1.

Applicant clarifies that claim 17 does not require antecedent basis for “having cutting threads” since such phrase appears in its first instance as a further limitation to the element “head component”, rather than as a reference to a previous instance in the claim of a “head component having cutting threads”. If helpful in clarifying this point by way of amendment to claim 17, applicant recommends an Examiner’s amendment offsetting the phrase “having cutting threads” in commas. There is no requirement that all additional limitations to elements appear in a particular order within the claims. Thus, applicant submits that claim 17, and claims 18-21 that depend from claim 17 are definite and in condition for allowance.

35 USC § 102

The Examiner rejects claims 11-13, 17, and 19-21 under 35 USC § 102 as being anticipated by HEHL, WO 00/67652 A2 (“Hehl”). Applicant respectfully traverses this rejection. In order to establish a *prima facie* case of anticipation under 35 USC § 102, a single reference must teach all the elements of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Hehl does not teach a wire as claimed in all of claims 11-13, 17, and 19-21. Hehl teaches a bolt. But, a bolt is not a wire. A bolt is defined as a metal

rod, pin, or bar. See "bolt." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 21 Dec. 2007. <Dictionary.com http://dictionary.reference.com/browse/bolt>. By contrast, a wire is defined as flexible or pliable and is specifically set forth in claims 11 and 17 as a "flexible wire". See "wire." *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. 21 Dec. 2007. <Dictionary.com http://dictionary.reference.com/browse/wire>. Thus, a bolt is not a wire, and Hehl fails to teach a flexible wire as claimed in claims 11-13, 17, and 19-21. Hehl fails to expressly teach any flexibility with respect to the bolt. Further Hehl fails to inherently teach flexibility of the bolt merely because a bolt can be bent. "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999) (citing Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991))." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002).

Failure to teach a wire in Hehl is particularly significant given the advantages provided by the claimed wire as illustrated in Figs. 4A and 4E, which illustrate wires that are not coaxial with their corresponding caps. By contrast, every bolt disclosed in Hehl is coaxial with its corresponding structures. A bolt cannot slide through a cap that is not coaxial with the bolt. But, a flexible wire can accommodate insertion through a non-coaxial cap. Thus, applicant submits that a *prima facie* case of anticipation has not been made and that claims 11-13, 17, and 19-21 are not anticipated by Hehl and are in condition for allowance.

Notwithstanding the above arguments, applicant hereby proposes amendments to independent claims 11 and 17, to further limit the "wire" to a wire "comprised of a thin metal" in order to further illustrate the distinctions between the claimed invention and the teachings of Hehl. Support for this amendment is found in the specification at paragraph 27.

35 USC § 103

The Examiner rejects claims 1-22 and 25 under 35 USC § 103(a) as being unpatentable over Dakin, U.S. Patent No. 6,368,326 ("Dakin") in view of Cachia, U.S. Patent No. 5,893,850 ("Cachia"). Applicant respectfully traverses this rejection. In addition to the arguments set forth

in previous responses to Office actions, the applicant submits that the combination of a locking sawtooth configuration with a wire as claimed was not obvious to one of ordinary skill in the art at the time of the invention.

First, applicant again submits that the Examiner has failed to identify a motivation to combine the teachings of Dakin and Cachia. In response, the Examiner asserts that “there is no requirement that a motivation to make the modification be expressly articulated.” Final Office action, page 7. However, the Federal Circuit clarified in 2006 that failure to set forth a motivation to combine supports an inference of hindsight analysis:

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. . . . The “motivation-suggestion-teaching” requirement protects against the entry of hindsight into the obviousness analysis, a problem which §103 was meant to confront...

In re Kahn, 441 F.3d 977, 78 USPQ2d 1329 (Fed. Cir. 2006). By failing to set forth a motivation to combine the teachings, the Examiner has used hindsight to reconstruct the teachings as set forth in the claims, which combination and motivation therefore was first identified by applicant as part of the invention. Applicant respectfully submits that the Examiner has failed to set forth a *prima facie* case of obviousness by failing to identify a motivation and using hindsight analysis. Thus, applicant submits that claims 1-22 and 25 are currently in condition for allowance.

Further, with regards to claim 20, the Examiner asserts that Dakin inherently teach removed excess wire beyond the cap by generally referring to “Figures 13” (see final Office action, page 5) without specifically referring to any line or reference numeral thereof. In *Ex parte Schricker*, 56 USPQ2d 1723, at 1725 (B.P.A.I. 2000), the Board of Patent Appeals and Interferences states:

[W]hen an examiner relies on inherency, it is incumbent on the examiner to point to the “page and line” of the prior art which justifies an inherency theory. . . . The examiner has

left applicant and the board to guess at the basis of the rejection and after having us guess would have us figure out (i.e., further guess) what part of which [prior art] document supports the rejection. We are not good at guessing; hence, we decline to guess.

In this case, the Examiner has failed to identify which portions of Figures 13 inherently teach removed excess wire beyond the cap. In Figures 13A and 13B, Dakin shows internal fasteners 90 embedded within the pelvis and, at the opposite end of the cords 92, screws 88 barricaded by the wall of an inner cup 84, making it impossible to remove any excess wire at either end of the cords 92. The Examiner has not shown that it is possible to remove excess wire as shown in Figures 13, and Dakin simply does not teach removing excess wire either expressly or inherently. Yet, even if it were possible to remove excess wire from the cords 92 set forth in Figures 13 of Dakin, inherency requires a different standard. “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may results from a given set of circumstances is not sufficient.” *EMI Group N. Am. Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423, 1429 (Fed. Cir. 2001). Further, “[i]nherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999) (citing *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2D (BNA) 1746, 1749 (Fed. Cir. 1991)).” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). Thus, applicant asserts that claim 20 is not obvious and is in condition for allowance.

Applicant asserts that dependent claims 2-10, 12-13, 15-16, 18-22 and 25 variously depend from independent claims 1, 11, 14 and 17, so claims 2-10, 12-13, 15-16, 18-22 and 25 are differentiated from the cited references for the same reasons as set forth in previous replies by the applicant and as set forth above, in addition to their own respective features.

Claims from Related Case

Related U.S. Patent No. 6,736,819 has already issued with claims similar to the claims in the current case. However, the current claims add an additional element directed towards the sawtooth configuration. Thus, the current claims should be in condition for allowance.

Applicant respectfully submits that the pending claims are in condition for allowance. The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account No. **19-2814**. Applicant invites the Examiner to telephone the undersigned, if the Examiner has any questions regarding this Reply or the present application in general.

Respectfully submitted,

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